

DOCKET NO.: 204478US6 PCT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 2135

Ryuji ISHIGURO, et al.

SERIAL NO: 09/701,084

EXAMINER: DADA, B. W.

FILED: June 6, 2001

FOR: INFORMATION PROCESSING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Bradley D. Lytle
Registration No. 40,073

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 07/05)

Scott A. McKeown
Registration No. 42,866

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REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF ANTICIPATION

Applicants submit that the Official Action of June 14, 2006 has failed to provide a *prima facie* case of anticipation with respect to Claims 6-8 and 53 under 35 U.S.C. § 102.¹

Pending Claims 6-8 and 53 stand rejected under 35 U.S.C. § 102 in view of Patel. As outlined in detail in the response filed August 10, 2006, this rejection is deficient in that it does not provide any discussion relative to the “key category” recitations of the Applicants’ claims.

In response to Applicants’ remarks filed August 10, 2006, the Official Action in the section entitled “Response to Arguments” asserts:

¹ See Official Action of June 14, 2006 detailing the rejection of Claims 6-8 and 53 under 35 U.S.C. § 102 based on U.S. Patent No. 6,591,364 (hereinafter Patel).

... Patel (US 6,591,364) teaches a reciprocal authentication (i.e., mutual authentication) with another processing apparatus to execute pre-set processing, comprising: receiving means for receiving a key category, a random number, and a device ID from another information processing apparatus (i.e., random number, type data and an id transmitted from the mobile device to the VLR) [column 3 line 65 – column 4 line 10 and figures 2-4].

**I. THE OFFICIAL ACTION FAILS TO IDENTIFY THE SELECTION OF A
RECIPROCAL AUTHENTICATION IN ACCORDANCE WITH A KEY CATEGORY**

Applicants' Claim 1 recites, *inter alia*, an information processing apparatus for reciprocal authentication with another information processing apparatus to execute pre-set processing, including:

... receiving means for receiving a key category, a random number, and a device ID from said another information processing apparatus;

selection means for selecting the processing for reciprocal authentication being executed from one or more reciprocal authentication procedures in keeping with said pre-set processing;

reciprocal authentication means for executing the selected reciprocal authentication procedures by said selection means **based on the key category**;.....(emphasis added)

Patel describes a method for establishing session key agreement between a mobile device and a visiting location register (VLR). In operation, a mobile device (20) communicates with the VLR to establish a session key.² In order to generate the session key, the VLR generates a random number R_n using a random number generator, and sends the random number R_n to the mobile (20) as a challenge along with a call termination request. The call termination request corresponds to type data which represents the type of protocol

² See Patel at Figure 2.

being performed. **The types of protocols include, for example, call termination, call origination mobile registration, etc.**³ In response, the mobile (20) generates a count value C_m , and performs a KCF on the random number R_n , the count value C_m , type data, and ID data zero using the SSDA as the key. The mobile (20) then sends count value C_m and KCF_{SSDA} (type, zero, C_m , R_n) to the network. Because the VLR initiated the current call termination protocol including the protocol for establishing a session key, the VLR knows the type data.⁴

Simply stated, Patel's **type data does not represent a key category**, but instead, **Patel's type data identifies an active protocol being performed such as call termination, call origination, mobile registration, etc.**⁵ Moreover, even assuming Patel's type data could be construed so broadly, such type data is not the same as the claimed key category as **it is not used to select a reciprocal authentication procedure** as recited in Applicants' Claim 6 or any claim depending therefrom.

II. THE RATIONALE OF THE OFFICE IS DEFICIENT WITH REGARD TO THE REQUIRED ANALYSIS.

As apparent from the above identified distinction, the required analysis with respect to the recited "reciprocal authentication means" and associated functions has not been performed. In this regard, the PTO reviewing court recently emphasized that conclusory findings that omit analysis as to "means" claim limitations are improper in Gechter v. Davidson 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was

³ Patel at column 3, lines 59-65.

⁴ Patel at column 3, line 66 to column 4, line 3.

⁵ Patel at column 3, lines 61-63.

structurally equivalent to that embodied in [the reference].
Moreover, the [PTO] also failed to define the exact function of
the receiving means, as well as to find that [the reference]
disclosed the identical function. [Emphasis added, citation
omitted.]

Thus, it appears that the outstanding Action is relying on conjecture or unfounded assumptions in suggesting that Patel describes a reciprocal authentication means in accordance with the identical function recited in the Applicants' claims, which, recites "reciprocal authentication means for executing the selected reciprocal authentication procedures by said selection means **based on the key category** ." However, this is clearly a modification of the actual teachings found at col. 3 line 65 – column 4 line 10 and figures 2-4 of Patel, and, such a modification to actual reference teachings using unfounded assumptions and/or speculation is improper. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.").

There is no PTO analysis as to how this completely dissimilar communication exchange can be said to be structurally equivalent to the Claim 6 reciprocal authentication means. Likewise, there is no PTO analysis as to the required explanation of how the Patel functions disclosed at the relied upon col. 3 line 65- col. 4 line 10 and figs 2-4 are identical to the functions claimed as to the reciprocal authentication means, as the above noted *Gechter* decision requires.

As independent Claims 7, 8 and 53 recite substantially similar limitations to that discussed above, Applicants respectfully submit that these claims are likewise allowable over the cited reference.

CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, Applicants respectfully request that prosecution be re-opened as the current grounds of rejection have not been clearly developed to such an extent that the Applicants can readily judge the Examiner's position or the advisability of preparing a traditional Appeal Brief.

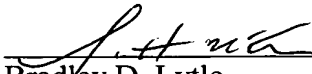
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Scott A. McKeown
Registration No. 42,866

BDL/SAM/ys